

## REMARKS

Claims 25-42 are pending in this application. Claims 1-24 have been previously cancelled, claim 25 and 31 have been amended and claims 35-42 have been added. The foregoing amendments are taken in the interest of expediting prosecution and there is no intention of surrendering any range of equivalents to which Applicant would otherwise be entitled in view of the prior art.

### Rejection Under 35 USC §112

Claims 25-34 stand rejected under 35 USC §112, first paragraph, as failing to comply with the written description requirement. More particularly, the Examiner asserts that the abutment plate being in the interior of the drum brake assembly is not disclosed in the original disclosure. Applicants respectfully disagree.

An objective standard for determining compliance with the written description requirement is, "does the description clearly allow persons of ordinary skill in the art to recognize that he or she invented what is claimed." *In re Gosteli*, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989). Under *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991), to satisfy the written description requirement, an applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention, and that the invention, in that context, is whatever is now claimed. The fundamental factual inquiry in determining whether the written description requirement has been satisfied is whether the specification conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, applicant was in possession of the invention as now claimed. See, e.g., *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991).

The present application clearly allows a person of ordinary skill in the art would recognize that the abutment plate may be placed in the interior portion of a drum brake assembly. The present invention is directed towards a backing plate which is used to support components of a drum brake assembly. As one skilled in the art would appreciate, backing plates are used for mounting drum brake components and shielding the same from dust or other harmful debris. In forming drum brake assemblies, an interior portion is formed by the shield plate and brake drum.

Figure 2 of the present application clearly shows the interior and exterior portion of the backing plate and hence a drum brake assembly. The Examiner appears to have fully understood this claim feature as the Office Action asserts that this feature is taught by JP 63-45229. See Office Action p. 5, lines 7-8. For at least these reasons, Applicants are of the opinion that the present application reasonably conveys to one skilled in the art that the abutment plate may be located on an interior portion of a drum brake assembly.

Notwithstanding, pursuant to 37 CFR §1.116, Applicants have amended claim 25 to recite that the abutment plate is located on an interior portion of the shield plate.

Claim 31 stands rejected under 35 USC §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claims the subject matter which application regards as the invention. More particularly, the Examiner asserts that there is insufficient antecedent basis for the claim limitation "the sides", as recited in claims 31.

Applicants have amended claim 31 to simply render the rejection moot.

#### Drawing Objection

The drawings stand objected to under 37 CFR §1.83(a) for failing to show every feature of the invention specified in the claims. More particularly, the Examiner asserts that the claim feature of the abutment plate being in the interior of the drum brake assembly is not shown in the drawings.

In view of the amendment to claim 25, as discussed above with reference to the 35 USC §112 rejection, Applicants are of the opinion that this objection has been rendered moot.

#### Rejection under 35 USC §103

Claims 25-34 have been rejected under 35 USC §103 as being obvious based upon DE 4203173, Buchholz et al., and in view of JP 63-45229 and in further view of US Patent No. 5,896,958, to Ludke et al. with respect to claim 32. Applicants respectfully disagree as the Office Action has failed to formulate a prima facie case of obviousness with respect to the claims, as described below.

At the onset, Applicants note that the Examiner acknowledges, explicitly or implicitly, that primary reference Buchholz et al. fails to teach the following features of claim 25:

- i. Shield plate having a thickness of 0.8 mm to 1.8 mm.
- ii. Shield plate being formed of damped steel.
- iii. The damped steel including a first and second layer equal in thickness and an intermediate layer formed of viscoelastic polymer.
- iv. The abutment plate having a thickness of 3 mm to 6 mm.
- v. An abutment plate located on an interior portion of the drum brake assembly.
- vi. The abutment plate having upper portion that is generally square.
- vii. The abutment plate having a lower portion having a shape generally corresponding to an anchor block.
- viii. The abutment plate having an intermediate portion having a width less than the width of the upper portion.

Furthermore, the Examiner asserts that the shape and dimension recited in claim 25, 26, 27, 29, 30 and 31 cannot distinguish the present invention from the prior art because they are merely design choices. The Examiner does not present any other reference to teach these features.

The Examiner asserts that “with regards to the shape of the abutment plate and the dimensions of the abutment plate and the shield plate, these claimed features are considered to be engineering design choices wherein these choices can be selected to achieve a desired level of dampening”. However, this assertion appears to be nothing more than an attempted application of per se rule, the kind of which has been admonished. This is because the Examiner never demonstrates how the suggested modification would achieve a desired level of dampening, particularly when the present invention seeks to not only reduce noise but also weight and cost. The CAFC wrote in the case of *In re Ochiai*, 37 USPQ2d 1127, 1133 (CAFC 1995) that:

The use of per se rules, while undoubtedly less laborious than a searching comparison of the claimed invention -- including all its limitations -- with the teachings of the prior art, flouts section 103

and the fundamental case law applying it. Per se rules that eliminate the need for fact-specific analysis of claims and prior art may be administratively convenient for PTO examiners and the Board. Indeed, they have been sanctioned by the Board as well. But reliance on per se rules of obviousness is legally incorrect and must cease. Any such administrative convenience is simply inconsistent with section 103, which, according to *Graham* and its progeny, entitles an applicant to issuance of an otherwise proper patent unless the PTO establishes that the invention as claimed in the application is obvious over cited prior art, based on the specific comparison of that prior art with claim limitations. We once again hold today that our precedents do not establish any per se rules of obviousness, just as those precedents themselves expressly declined to create such rules. Any conflicts as may be perceived to exist derive from an impermissible effort to extract per se rules from decisions that disavow precisely such extraction.

Furthermore, this has been reinforced in the recent US Supreme Court case *KSR International Co. v. Teleflex Inc.* 04-1350, decided April 30, 2007, wherein the court held that “a court errs where...it transforms general principle into a rigid rule limiting the obviousness inquiry.” Pp. 14-15. In this holding, the court reemphasized the inquiry principles of obviousness developed in *Graham v. John Deere*, 383 U.S. 1, 17-18 (1966). Under the *Graham* analysis, the Examiner is required to:

- i. determine the scope and content of the prior art;
- ii. ascertain the differences between the prior art and the claims at issue;
- iii. resolve the level of ordinary skill in the pertinent art; and
- iv. evaluate evidence of secondary consideration.

In view of the foregoing, the use of per se rules to assert obviousness of the dimension and shape of the abutment plate, as claimed, is impermissible. For at least these reasons, the rejections of claims 25, 26, 27, 29, 30 and 31 are believed to be improper.

With regards to the abutment plate being attached to an interior portion of a shield plate of the drum brake assembly, as recited in claim 25, the Office Action has failed to provide any motivation, whatsoever, on why one skilled in the art would modify the system of Buchholz et al. to include this supposed feature of JP ‘299. See

*Graham* and MPEP § 2143.01. **The initial burden is on the Examiner to provide some suggestion of the desirability of doing what the inventor has done.** See MPEP §2142. This is further reinforced by the recent Supreme Court case *KSR*, wherein the Court specifically stated:

Often, it will be necessary to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, **this analysis should be made explicit**. *KSR*, p. 14 (emphasis added).

Furthermore, it is not clear whether there is a reasonable expectation of success of the proposed modification given the large size of the abutment plate of Buchholz et al. and the configuration of the components located on the interior side of the shield plate. See MPEP §2143.02. For at least these reasons, the Examiner has failed to form a *prima facie* case of obviousness with regards to claim 25.

In view of the foregoing, Applicants believe the rejections to independent claim 25 and dependent claims 26-34 have been traversed and/or rendered moot. Applicants do not acquiesce to the other asserted rejections but instead reserve the right to address these rejections at a later date.

By amending the application, the Applicants do not concede that the patent coverage available to them would not extend as far as the original claim. Rather, Applicants reserve the right to file a continuation application to pursue the breadth of the claims as filed. Applicants believe that the Examiner has not made a sufficient showing of inherency of the teachings of the asserted prior art, especially given the lack of teachings in the cited references of the properties that Applicants have recited in their claims.

Further, by the present amendment, it does not follow that the amended claims have become so perfect in their description that no one could devise an

equivalent. After amendment, as before, limitations in the ability to describe the present invention in language in the patent claims naturally prevent the Applicants from capturing every nuance of the invention or describing with complete precision the range of its novelty or every possible equivalent. See, Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., 62 USPQ2d 1705 (2002). Accordingly, the foregoing amendments are made specifically in the interest of expediting prosecution and there is no intention of surrendering any range of equivalents to which Applicants would otherwise be entitled.

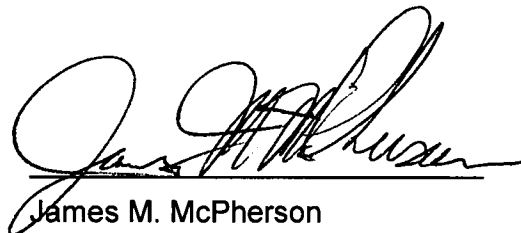
### **CONCLUSIONS**

In view of Applicants' amendments and remarks, the Examiner's rejections are believed to be rendered moot. Accordingly, Applicants submit that the present application is in condition for allowance and requests that the Examiner pass the case to issue at the earliest convenience. Should the Examiner have any question or wish to further discuss this application, Applicant requests that the Examiner contact the undersigned at (248) 292-2920.

If for some reason Applicants have not requested a sufficient extension and/or have not paid a sufficient fee for this response and/or for the extension necessary to prevent the abandonment of this application, please consider this as a request for an extension for the required time period and/or authorization to charge Deposit Account No. 50-1097 for any fee which may be due.

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